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OSTRUP, CLINTON T

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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*Ex parte* TONY REID

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Appeal 2009-2677  
Application 10/725,837  
Technology Center 3700

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Decided:<sup>1</sup> April 28, 2009

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Before TONI R. SCHEINER, DEMETRA J. MILLS, and ERIC GRIMES,  
*Administrative Patent Judges.*

GRIMES, *Administrative Patent Judge.*

**DECISION ON APPEAL**

This is an appeal under 35 U.S.C. § 134 involving claims 1-10, all of the pending claims, which are directed to a device for treating swelling. The

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Examiner has rejected the claims as obvious. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

#### STATEMENT OF THE CASE

This application was the subject of an earlier appeal to this Board (Appeal 2006-1887, decided Jan. 8, 2007). The claims had been rejected under 35 U.S.C. § 103 as obvious in view of Deasy<sup>2</sup> and Myers.<sup>3</sup>

At the time of Appeal 2006-1887, the independent claims read as follows (emphases added):

1. A system for applying pressure to a body limb, said system comprising:

a first sleeve having a foam lining configured to be slid over the limb and to apply an inward pressure onto the limb;  
and

a second sleeve configured to be slid over *substantially the entire length of the first sleeve* and to apply additional inward pressure along the length of the limb.

5. A system for applying pressure to an arm, the system comprising:

an innermost therapeutic pressure sleeve (TPS) having ridges formed over an inner surface and configured to be slid over the entire length of the arm from the shoulder to the wrist and to apply an inward pressure thereon; and

at least a second sleeve configured to be slid over *substantially the entire length of the TPS* to apply additional inward pressure onto the limb.

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<sup>2</sup> Deasy Jr., U.S. Patent 5,171,211, issued Dec. 15, 1992.

<sup>3</sup> Myers, U.S. Patent 814,795, issued Mar. 13, 1906.

The Board in Appeal 2006-1887 affirmed the rejection of then-pending claims 1-10 as obvious in view of Deasy and Myers (opinion in Appeal 2006-1887, page 10). Appellant filed a Request for Continued Examination and amended the claims. Claims 1 and 5, the only independent claims, as they currently stand read as follows:

1. A system for applying pressure-to a body limb, said system comprising:  
a first sleeve comprising a cylindrical body open at both ends, having a foam lining, and being configured to be slid over the full length of the limb and to apply an inward pressure onto the limb; and  
a second sleeve comprising a cylindrical body open at both ends and being configured to be slid wholly over the entire length of the first sleeve such that the second sleeve will have the same length as the first sleeve and will apply additional inward pressure along the full length of the limb when the second sleeve is in place over the first sleeve.

5. A system for applying pressure to an arm, said system comprising:  
an innermost therapeutic pressure sleeve (TPS) comprising a cylindrical body open at both ends having ridges formed over an inner surface and configured to be slid over the entire length of the arm from the shoulder to the wrist and to apply an inward pressure thereon; and  
at least a second sleeve comprising a cylindrical body open at both ends being configured to be slid wholly over the entire length of the TPS such that the second sleeve will have the same length as the first sleeve and will apply additional inward pressure onto the limb when the second sleeve is in place over the first sleeve.

## OBVIOUSNESS

### *Issue*

The Examiner has rejected claims 1-10 under 35 U.S.C. § 103 as obvious in view of Deasy and Myers (Answer 4). The Examiner finds that Myers teaches a device meeting all the limitations of claims 1 and 5 “except

for the second sleeve having the same length as the first sleeve for applying additional inward pressure along the full length of the limb” (Answer 4).

The Examiner finds that Deasy discloses a device for applying pressure to a limb comprising “a first sleeve 18 . . . [and] a second sleeve 46 configured to be slid over substantially the entire length of the first sleeve” (*id.* at 5).

The Examiner concludes that “Deasy already teaches that the second sleeve is configured to be slid over most of the length of the first sleeve . . . , therefore it would have been an obvious matter of design choice to modify the size of the second sleeve of Myers to be the same length as the first sleeve, for the purpose of . . . enhancing the effectiveness of the compression therapy” (*id.*).

Appellant contends that all of the claims on appeal require that the first and second sleeves have the same length, and Myers and Deasy do not suggest this limitation, even considered together (Appeal Br. 5).

The issue presented is: Has the Examiner shown that a person of ordinary skill in the art would have considered it obvious to modify the garment of Myers or Deasy to have an inner and outer sleeve of the same length?

#### *Findings of Fact*

1. Myers discloses an elastic bandage or compressive covering that “may be made of any suitable material, as rubber or other flexible substance” (Myers 1: 8-9, 35-36).

2. Myers’ device includes “a series of outer encircling bands, which may either be integral or separately applied in order to give greater compression than the bandage alone at any desired point” (*id.* at 1: 42-46).

3. Deasy discloses “an elastic garment which can be worn for therapeutic reasons or to improve one’s endurance and stamina” (Deasy, col. 1, ll. 14-16).

4. Deasy discloses that a prior art elastic garment “is similar to a tight pair of pants but . . . is made of a relatively heavy and extremely elastic fabric. The garment extends the full length of the legs and around the ankles so as to partially enclose the feet. The garment is manufactured by Truform of Cincinnati, Ohio, and is marketed under the brand name ‘Legotards.’” (*Id.* at col. 1, ll. 56-62.)

5. Deasy states that the Truform garment “is extremely difficult to get into. . . . As a result, it has very severe limitations in use. By way of example, it is nearly impossible for a bedridden patient to put the garment on even though once the garment is on it has significant therapeutic value.” (*Id.* at col. 1, l. 64 to col. 2, l. 2.)

6. Deasy discloses a garment intended “to overcome the limitations in the above-noted prior art devices” (*id.* at col. 2, ll. 3-4).

7. Deasy’s garment “includes a pant-like portion 12 . . . , a pair of tubular leg portions 14 . . . , a coat-like portion 16 . . . , and a pair of tubular arm portions 18” (*id.* at col. 3, ll. 34-37).

8. The pants-like portion of Deasy’s garment extends from the waist to past the knee joint (*id.* at col. 3, ll. 44-47).

9. The leg portions of Deasy’s garment extend from the middle of the foot to above the knee joint “so as to form an overlap with the leg segments 22 of the pant-like portion” (*id.* at col. 4, ll. 1-9).

10. The coat-like portion of Deasy's garment covers the wearer's torso and extends down the arms past the elbow joints (*id.* at col. 4, ll. 11-15).

11. The arm portions of Deasy's garment "extend from the wrist of a user up beyond the elbow joint 48 so as to form an overlap with the sleeves 46 of the coat-like portion" (*id.* at col. 4, ll. 31-34).

12. The edge of each portion of Deasy's garment is formed into an enlarged bead by rolling the edge over itself several times (*id.* at col. 3, ll. 56-60; col. 4, ll. 1-5, 15-19, 27-30).

13. Deasy discloses that the "enlarged beads along the edges of the components actually compress the body more than the remaining portions of the components and in effect act like a garter in compressing the body part of the user immediately beneath the bead" (*id.* at col. 4, ll. 49-53).

14. Deasy discloses that "the garment is relatively easy to put on and take off due to the fact that the portions of the garment covering the arms and legs are in segments rather than in one continuous part as with the Legotard garment [s]old by Truform" (*id.* at col. 5, ll. 9-14).

15. Deasy discloses that "it is felt that the garter effect at locations above and below both the knee joints and the elbow joints provides anatomical reactions which improve the therapeutic and other benefits of the garment" (*id.* at col. 5, ll. 16-19).

### *Principles of Law*

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or

argument shift to the applicant.” *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993).

“[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. . . . [I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418, 127 S.Ct. 1727, 1741 (2007).

“We must still be careful not to allow hindsight reconstruction of references to reach the claimed invention without any explanation as to how or why the references would be combined to produce the claimed invention.” *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1374 n.3 (Fed. Cir. 2008).

“The fact that the motivating benefit comes at the expense of another benefit . . . should not nullify its use as a basis to modify the disclosure of one reference with the teachings of another. Instead, the benefits, both lost and gained, should be weighed against one another.” *Medichem S.A. v. Rolabo S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006).

### *Analysis*

Myers discloses a compressive covering that can include “encircling bands” to provide additional compression at certain points. Myers does not, however, suggest any reason to provide an encircling band or outer sleeve that extends the full length of the inner compressive covering.

Deasy discloses a compressive garment made up of different parts that overlap around the elbows and knees. Deasy discloses that a prior art



garment that extends the full length of the legs is extremely difficult to get into. Deasy discloses that making the arm and leg portions of the garment in segments, rather than as one continuous part, makes the garment easier to put on and take off. Deasy also teaches that having the edges of the different portions located above and below the knees and elbows creates a “garter effect” that improves the therapeutic and other benefits of the garment. Deasy thus teaches that having an inner and outer sleeve that are of different lengths and do not overlap over the entire length of the limb provides advantages over a prior art device that provides uniform compression over the entire length of a limb.

The Examiner finds that a person of ordinary skill in the art would have considered it obvious to modify the prior art device to make the inner and outer sleeves the same length in order to enhance the effectiveness of the compression therapy (Answer 5). The Examiner has pointed to nothing in either Myers or Deasy, however, to show that those of skill in the art would have expected inner and outer sleeves of the same length to enhance the effectiveness of compression therapy. As discussed above, Deasy appears to support the opposite conclusion, since it teaches that the garter effect resulting from less-than-complete overlap between the various portions improves the therapeutic benefits of the garment.

The Examiner is certainly correct that “the mere modification of the size of the device, taught by the combined references, is a modification within the skill of one of ordinary skill in the art” (Answer 9). The relevant question, however, is whether the modification would have been an obvious one to those of ordinary skill in the art. *See In re Fritch*, 972 F.2d 1260,

1266 (Fed. Cir. 1992) (“The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.”). In this case, we conclude that the Examiner had not provided adequate evidence to support a conclusion that the difference between the claimed and prior art devices would have been obvious.

#### CONCLUSION OF LAW

The Examiner has not shown that a person of ordinary skill in the art would have considered it obvious to modify the garment of Myers or Deasy to have an inner and outer sleeve of the same length.

#### SUMMARY

We reverse the rejection of claims 1-10 under 35 U.S.C. § 103 as obvious in view of Deasy and Myers.

#### REVERSED

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